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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|------------------|
| 10/091,038  | 03/05/2002  | Teemu Puskala        | 042933/319824                   | 8149             |
| 826 7590 07/09/2008<br>ALSTON & BIRD LLP<br>BANK OF AMERICA PLAZA<br>101 SOUTH TRYON STREET, SUITE 4000<br>CHARLOTTE, NC 28280-4000 |             |                      | EXAMINER<br>THOMASSON, MEAGAN J |                  |
|   |             |                      | ART UNIT                        | PAPER NUMBER     |
|   |             |                      | 3714                            |                  |
|   |             |                      | MAIL DATE                       | DELIVERY MODE    |
|   |             |                      | 07/09/2008 PAPER                |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/091,038

**Applicant(s)**

PUSKALA, TEEMU

**Examiner**

MEAGAN THOMASSON

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 14-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
- Paper No(s)/Mail Date 3/6/08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Terminal Disclaimer***

The terminal disclaimer filed on March 12, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 6,908,389, issued June 21, 2005, has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Response to Amendment***

The examiner acknowledges the amendments made to claims 1,16,19,22-24,26-27,31-38,41-43 and 46-50. Claim 13 has been canceled; claims 1-12 and 14-50 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-12,14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 1 recites the limitations "providing means for providing for providing along with the transmitted certain content at least one content-related predefined message to the user of the at least one wireless terminal", "at least one wireless terminal at least for

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receiving the certain content and the at least one content-related predefined message **from the online service of said service platform through the wireless network**" (emphasis added), and "selecting means for enabling selecting, by the user of said at least one wireless terminal, whether to **originally transmit** one or more of the provided at least one content-related predefined messages wirelessly from said at least one wireless terminal" (emphasis added). It appears it was applicant's intent for the phrase "originally transmit" to mean the transmission from wireless terminal (as selected by the user) is the first, or original, transmission of the content-related predefined message. It is unclear as to how this can be true if the "original", or first, transmission of the content related predefined message was from the server to the wireless terminal, as recited in the claim. Therefore, this limitation renders the claim indefinite.

For purposes of examination, the examiner will interpret the phrase "originally transmit" to mean "transmit the message in its original form", i.e. to transmit without altering the content related predefined message that has been received from the server on the user's wireless terminal. That is, if the message is unaltered after it has been received from the service platform by the wireless terminal, then it may be said to be "originally transmitted" if it is forwarded by the wireless terminal to an intended recipient.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-12,14-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackintosh et al. (US 6,317,784 B1) in view of Rouse et al. (US 6,983,310 B2).**

Regarding claims 1,16,41-46,49 Mackintosh discloses a system for enhancing communication on a wireless network using predefined messages, comprising a service platform running an on-line service, the on-line service for providing a certain content (Fig. 5, Broadcast internet service provider), the service platform comprising transmitting means for transmitting the certain content to a user of at least one wireless terminal, referred to by Mackintosh as broadcast material where broadcast material may include music tracks, advertising tracks, etc. (col. 2, line 42-col.3, line 16), and providing means for providing along with the transmitted certain content at least one content-related predefined message to the user of the at least one wireless terminal based upon the certain content, the message being generated independently of the certain content and automatically modified based on an identity of the certain content. Specifically, Mackintosh discloses the ability to deliver content, i.e. a music track, in combination with a content-related predefined message (col. 3, lines 42-67) to a user terminal via a

wireless communication system (col. 24, line 55 - col. 25, line 4). Referring to Fig. 12, the content-related predefined message comprises the information fields "artist", "song", "album" and album cover (field **518**) that are generated independently of the certain content and automatically modified based on an identity of the certain content. These fields are predefined and generated independently of the certain content, as they are displayed to the player irrespective of the track being played, but are modified to include data pertinent to the track currently being played.

*Mackintosh does not specifically disclose the at least one wireless terminal further comprises selecting means for enabling selecting, by the user of said at least one wireless terminal, whether to originally transmit one or more of the provided at least one content-related predefined messages wirelessly from said at least one wireless terminal, and transmitting means for originally transmitting, if the user of said at least one wireless terminal selects to transmit one or more of the provided content-related predefined messages, the selected content-related message to at least one address selectable by the user of said at least one wireless terminal.* However, Mackintosh does disclose a communications interface "that allows software and data to be transferred between computer system **702** and external devices", wherein this "can be implemented using a wireless medium" including a cellular phone link (col. 24, line 55 - col. 25, line 4). Additionally, Rouse discloses a system for enabling users of wireless devices to send and receive messages and other information (abstract), including content-related predefined messages (col. 3, lines 27-33). Specifically, Rouse discloses selecting means for enabling selecting whether to originally transmit one or more messages from

the wireless terminal in col. 9, lines 43-46. That is, phone keys provide the wireless device user with the ability to select a forward option 718, which enables a user to forward a selected message to a recipient (col. 9, lines 14-35).

The phrase "originally transmit" has been interpreted by the examiner to mean "transmit the message in its original form", i.e. to transmit without altering the content related predefined message that has been received from the server on the user's wireless terminal. That is, if the message is unaltered after it has been received from the service platform by the wireless terminal, then it may be said to be "originally transmitted" if it is forwarded by the wireless terminal to an intended recipient. This is a notoriously well known feature of message forwarding, wherein one user sends a previously received message, in its original form, to a second user.

Additionally, Rouse discloses transmitting means for wirelessly transmitting at least one message (col. 5, lines 45-48; col. 10, lines 3-24) to at least one address selectable by the user of said at least one wireless terminal (col. 9, lines 47-55).

The ability to forward messages among cell phone users, e.g. "text messaging", is well known to one of ordinary skill in the art. To implement such a feature in a system such as the one taught by Mackintosh, which contemplates wireless communication capabilities between cellular phones, would have required only routine skill in the art. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Mackintosh and Rouse as Mackintosh discloses the ability to communicate with external devices via a cellular phone link, as discussed above. All of the claimed elements were known, i.e. providing content and content-

related predefined messages to a user of a wireless device and the ability to forward messages among users of wireless devices including cellular phones, at the time of the invention and could have been combined by one of ordinary skill in the art in order to produce predictable results.

Regarding claims 2-4,17-20 wherein the at least one address selectable by the user comprises a predetermined address of at least one other wireless terminal (col. 3, lines 38-45; col. 9, lines 47-55).

Regarding claims 5,21, the at least one other terminal comprises a wireless terminal (Rouse, col. 3, lines 33-45).

Regarding claims 6,22,32 Rouse discloses means for assessing an output capability of said at least one other terminal to receive the predefined message, and means for configuring the predefined message, prior to transmitting the predefined message to the address of the at least one other terminal, so that the output capability of the at least one other terminal to receive the predefined message is taken into consideration (col. 3, lines 46-50; col. 5, lines 6-26).

Regarding claims 7,23,47 Mackintosh discloses the providing means comprises a content determining means for determining the content of the online service ("cut number" col. 9, lines 8-34).

Regarding claims 8,12,24,27 Mackintosh discloses said providing means receives a predefined criteria and generates or selects the predefined message based upon the predefined criteria. That is, Mackintosh discloses the cut number provides information relating to the type of cut, i.e. content, including any of music, ad traffic, EJ



segments, etc (col. 9, lines 10-25). If the identified content is a music track, the predefined message will contain information fields such as song, album title, etc., as discussed above with respect to claim 1. If the content is an advertisement segment, the predefined message will contain information fields such as company logos, product pictures, etc., (col. 13, lines 16-22), wherein said fields are automatically modified (i.e. filled in) based upon the advertising segment content.

Regarding claims 9,25,34 Rouse discloses both terminals may be mobile phones (col. 1, lines 16-21).

Regarding claims 10,35 wherein the at least one wireless terminal comprises a dedicated button to cause the content-related predefined message to be transmitted to the selected address, the "Send" button on any cellular phone acts as a dedicated button to begin a transmission.

Regarding claims 11,26 Rouse discloses an indicator to be displayed to indicate that at least one content-related predefined message is available for selection (col. 8, lines 5-8).

Regarding claims 14,28 Mackintosh discloses the predefined message is stored in and retrieved by the providing means from a storage device in the service platform (Fig. 1).

Regarding claims 15,30,38 Mackintosh discloses the predefined message comprises at least one of voice, text, sound, an image, a picture and a video (Fig. 12).

Regarding claim 31, in addition to the invention described above, Rouse discloses the wireless terminal comprises a processor in communication with a data

storage device, a primary input in communication with the processor, and an interactive program operative on the processor (col. 5, lines 27-60; col. 7, lines 1-49).

Regarding claim 33,47, see claims 39 and 8 above.

Regarding claim 36, Rouse discloses the apparatus of claim 31 may be a cellular phone, PDA, pager, etc. (col. 1, lines 16-21). These devices inherently comprise data storage devices.

Regarding claim 37, Rouse discloses the data storage device may be located in a service platform (col. 5, lines 33-37).

Regarding claims 39,40 wherein the on-line service comprises at least one of an Internet web site and a network server providing at least one of an interactive program and streaming audio and/or video (Mackintosh, col. 8, lines 33-65).

Regarding claims 48 and 50, Rouse discloses the service platform has a communication link with the content provider (Fig. 1).

### ***Response to Arguments***

Applicant's arguments, see Remarks P. 13, filed March 12, 2008, with respect to the rejection(s) of all claim(s) under 35 U.S.C. 103(a) as being unpatentable over Mackintosh and Sivula have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. Specifically, the examiner acknowledges that Sivula was assigned to the same entity as that to which the instant invention was assigned at the time the instant invention was made. Because Sivula is applicable as prior art under 35 U.S.C. 102(e), it is therefore prohibited from being used in an obviousness rejection as

stated in 35 U.S.C. 103(c). However, upon further consideration, a new ground(s) of rejection is made in view of Rouse et al (US 6,983,310 B2).

In view of the new grounds of rejection, applicant's arguments drawn to the teachings of Sivula have been rendered moot.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MEAGAN THOMASSON whose telephone number is (571)272-2080. The examiner can normally be reached on M-F 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Meagan Thomasson/

July 2, 2008

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3714